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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,092	07/30/2001	Elaine V. Morley	MORL-25,783	2040
23640	7590	11/17/2005	EXAMINER	
BAKER BOTTS, LLP 910 LOUISIANA HOUSTON, TX 77002-4995			OUELLETTE, JONATHAN P	
		ART UNIT	PAPER NUMBER	
		3629		

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/918,092	MORLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 August 2005 and 22 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-67 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Response to Amendment*

1. Claims 40-67 have been added. Claims 1-67 are now pending in application 09/918,092.

### **Claim Rejections - 35 USC § 101**

2. The rejection of Claims 1, 4, and 5 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, is withdrawn due to Applicant's amendments.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. **Claims 1-22, 25-26, 28-29, and 40-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS (United States Citizenship and Immigration Services Website, uscis.gov, pgs 1-39) in view of Stiegemeier et al. (US 6,192,381 B1).**
5. As per independent Claim 1, USCIS discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: viewing at least one of the employee's original documents (pgs. 3-5, instructions for I-9 completion), such that a sufficient number of the employee's

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original documents are viewed for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes (pgs. 3-5, completing I-9); the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing (pgs. 4); running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates included in the relevant data; the step of running checks including the step of comparing with a list of acceptable documents the document type of the at least one of the employee's original documents viewed for employment verification (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

6. USCIS fails to expressly disclose using a data processing system to complete the document.
7. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs. 1-5), to include recording the expiration date of the

provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5); and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date, gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

8. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and analysis of an expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
9. USCIS also fails to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.
10. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).

11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.
12. As per Claims 2, 11, and 16, USCIS and Stiegemeier fail to expressly disclose displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention.
13. However, USCIS discloses revising the I-9 form and instructions when changes regarding regulations not incorporated into the verification rules are necessary (the form displayed on pgs. 3-5 was revised 11/21/91).
14. Furthermore, official notice is given that electronic notice boards (publicly viewable information updates) were well known and used at the time the invention was made.
15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention, in the system disclosed

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by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by ensuring that users are fully aware of all changes/updates to the method/system.

16. As per Claims 3, 13, and 18, USCIS and Stiegemeier disclose wherein employee data provided by the employee and entered into the data processing system is compared to data for the employee listed on a remote server to audit the accuracy of the employee data (USCIS: Employment Verification Pilot – SAVE Program, pgs. 22-25).
17. As per Claims 4, 10, and 17, USCIS and Stiegemeier disclose wherein the step of viewing at least one of the employee's original documents comprises the steps of viewing two separate documents of the employee's original documents, which includes the step of viewing a first one of the two separate documents establishing the identity of the employee and the step of viewing a second one of the two separate documents establishing the employment eligibility for the employee (USCIS employment verification process, list b and c documents, pgs. 3-5).
18. As per Claims 5, 12, and 19, USCIS and Stiegemeier disclose displaying an alert from a listing of alerts when a particular document type is selected from the list of acceptable documents.
19. However, Stiegemeier discloses selecting an electronic document (C4 L1-21).
20. Furthermore, official notice is given that automatically displaying an alert in regards to a user action taken on an electronic application (beep, highlighting, blinking cursor) was well known and used at the time the invention was made.

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry, in the system disclosed by Stiegemeier, in the system disclosed by Ghosh, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by visually informing the consumers of actions taken as part of completing the method.
22. As per Claims 6 and 20, USCIS and Stiegemeier disclose wherein the documents are selected from a pull-down menu listing only acceptable types of documents (Stiegemeier: C6 L57-65, Drop-down list).
23. As per Claims 7 and 14, USCIS and Stiegemeier fail to expressly disclose displaying employer editable tips, which are displayed when particular ones of the fields are selected.
24. However, USCIS discloses providing information on how to properly fill out the verification document (pgs. 3-5).
25. Furthermore, official notice is given that field specific help indexes (help windows) were well known and used at the time the invention was made.
26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying employer editable tips which are displayed when particular ones of the fields are selected, in the system disclosed by

Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by ensuring that users correctly use and enter information into the document for further use/analysis evaluation in the method.

27. As per **independent Claim 8**, USCIS discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: selecting at least one of the employee's original documents from a list of acceptable documents sufficient for establishing identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); viewing at least one of the employee's original documents, such that a sufficient number of the employee's original documents are views for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes (pgs. 3-5, I-9 completion); the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing; running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates included in

the relevant data (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

28. USCIS fails to expressly disclose using a data processing system to complete the document.
29. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs. 1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5), and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it to the current date gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.
30. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and determining of an expiration date (expiration date on provided document compared to current time/date) because this would speed up

the process of verifying documentation of employees, which is purely known; and an expected result from automation of what is known in the art.

31. USCIS fails to expressly disclose displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu.
32. Stiegemeier discloses an automated system for managing the creation of documents, to include providing a user interface for a user to select desired document-editing operations (C3 L4-60, user interface, document manager).
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting /verifying employee eligibility information, with the ability to increase the effectiveness of the method, by organizing the document information into a user friendly operation system.
34. USCIS also fails to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.

35. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).
36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.
37. As per Claim 9, USCIS and Stiegemeier disclose wherein the step of viewing at least one of the employee's original documents comprises the steps of selecting two separate documents of the employee's original documents, which includes the step of selecting a first one of the two separate documents establishing the identity of the employee and the step of selecting a second one of the two separate documents establishing the employment eligibility for the employee (USCIS: employment verification process, list b and c documents, pgs. 3-5).
38. As per **independent Claim 15**, USCIS discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: viewing at least one of the employee's original documents, such

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that a sufficient number of the employee's original documents are views for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes (pgs. 3-5, I-9 completion); the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing; running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates included in the relevant data; the step of running checks including the step of comparing with a list of acceptable documents the document type of the at least one of the employee's original documents viewed for employment verification (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

39. USCIS fails to expressly disclose using a data processing system to complete the document.
40. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the

provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5), and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

41. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and determining of a expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
42. USCIS fails to expressly disclose displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu.
43. Stiegemeier discloses an automated system for managing the creation of documents, to include providing a user interface for a user to select desired document-editing operations (C3 L4-60, user interface, document manager).

44. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting /verifying employee eligibility information, with the ability to increase the effectiveness of the method, by organizing the document information into a user friendly operation system.
45. USCIS also fails to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.
46. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).
47. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by

ensuring that all manually entered document field data is valid for future use/analysis in the method.

48. As per Claims 21, 25, and 28, USCIS and Stiegemeier fail to expressly disclose wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry.
49. However, Stiegemeier discloses filling in the fields of an electronic document (abstract).
50. Furthermore, official notice is given that automatically displaying an alert in regards to a user action taken on an electronic form/document (beep, highlighting, blinking cursor) was well known and used at the time the invention was made.
51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by visually informing the consumers of actions taken as part of completing the method.
52. As per Claims 22, 26, and 29, USCIS and Stiegemeier disclose the step of entering corrected relevant data into respective ones of the various fields in response to the generated error messages (Stiegemeier: C1 L44-46).

53. As per new **independent Claims 40 and 54**, USCIS and Stiegemeier disclose a method for assisting in documenting employment eligibility, comprising: displaying a field of an employment eligibility verification document; receiving data corresponding to the field (pgs. 3-5, instructions for I-9 completion); applying a rule to the received data; and recording predetermined text based at least in part on an outcome of applying the rule (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).
54. USCIS fails to expressly disclose using a data processing system to complete the document.
55. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5); and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date, gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only

provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

56. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and analysis of an expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
57. USCIS also fails to expressly disclose automatically applying a rule to the received data; and automatically displaying predetermined text based at least in part on an outcome of applying the rule.
58. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606).
59. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included automatically applying a rule to the received data; and automatically displaying predetermined text based at least in part on an outcome of applying the rule, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.
60. As per new Claims 41 and 55, USCIS and Stiegemeier disclose wherein the rule is applied to the received data before any other data is received.

61. As per new Claims 42 and 56, USCIS and Stiegemeier disclose where the predetermined text is part of an error report for multiple fields of the employment verification document.
62. As per new Claims 43 and 57, USCIS and Stiegemeier disclose where displaying a field of an employment eligibility verification document includes displaying the entire document.
63. As per new Claims 44 and 58, USCIS and Stiegemeier disclose where displaying predetermined text includes displaying the predetermined text in an overlaying window
64. As per new Claims 45 and 59, USCIS and Stiegemeier disclose where the rule requires received data is to match one of a set of values.
65. As per new Claims 46 and 60, USCIS and Stiegemeier disclose where receiving data corresponding to the field includes detecting the choice made by a user from a pulldown menu (Stiegemeier: C6 L57-65, Drop-down list).
66. As per new **independent Claims 47 and 61**, USCIS and Stiegemeier disclose a method (computer program) for assisting in documenting employment eligibility, comprising: displaying a field of an employment eligibility verification document; receiving time data corresponding to the field (pgs. 3-5, completing I-9); determining a current time; comparing the time data to one or more time values based at least in part on the current time (Check for Expiration); and recording predetermined text based at least in part on an outcome of comparing the time data to the time values (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

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67. USCIS fails to expressly disclose using a data processing system to complete the document.
68. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5); and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date, gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.
69. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and analysis of an expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.

70. USCIS also fails to expressly disclose automatically applying a rule (comparing the time data) to the received data; and automatically displaying predetermined text based at least in part on an outcome of applying the rule (comparing the time data to the time values).
71. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606).
72. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included automatically applying a rule to the received data; and automatically displaying predetermined text based at least in part on an outcome of applying the rule, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.
73. As per new Claims 48 and 62, USCIS and Stiegemeier disclose where displaying a field of an employment eligibility verification document includes displaying the entire document.
74. As per new Claims 49 and 63, USCIS and Stiegemeier disclose where the time data includes an expiration date.
75. As per new Claims 50 and 64, USCIS and Stiegemeier disclose where the time includes an expiration date for an employee's original document.

76. As per new Claims 51 and 65, USCIS and Stiegemeier disclose where determining a current time includes checking a computer system clock (inherent to systematic date calculations).
77. As per new Claims 52 and 66, USCIS and Stiegemeier disclose where the one or more of the time values based at least in part on the current time are a range of dates extending forward from the current time (expiration date check).
78. As per new Claims 53 and 67, USCIS and Stiegemeier disclose where displaying predetermined text includes displaying a warning when the time data matched one or more of the time values.
79. **Claims 23, 24, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS in view of Stiegemeier, and further in view of Ghosh et al. (US 2001/0032094 A1).**
80. As per Claims 23, 27, and 30, USCIS and Stiegemeier fail to expressly disclose the step of storing the relevant data in a data storage, then running an electronic review of the relevant data to determine various data required for a particular employer to comply with verification of employment eligibility requirements, and displaying a report indicating such various data required for compliance.
81. Ghosh discloses a system for tracking and maintaining document information, and automatically contacting and notifying system users of upcoming expirations (Para 0014).
82. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included storing the relevant data in a data storage, then

running an electronic review of the relevant data to determine various data required for a particular employer to comply with verification of employment eligibility requirements, and displaying a report indicating such various data required for compliance, as disclosed by Ghosh, in the system disclosed by Stiegemeier, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all document field data is current, valid, and usable for future use/analysis in the method.

83. As per Claims 24, USCIS, Stiegemeier, and Ghosh fail to expressly disclose wherein the step of displaying a report only displays such data required which defines curable defects.
84. However, Ghosh does disclose automatically contacting and notifying system users of upcoming expirations (Para 0014), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to only display/notify users of curable defects (expiration dates), as it would have been a waste of system resources and user time/effort to be notified of defects incurable by the user.
85. **Claims 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS in view of Ghosh et al. (US 2001/0032094 A1).**
86. As per **independent Claim 31**, Stiegemeier discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: viewing at least one of the employee's original documents, such that a sufficient number of the employee's original documents are views for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9

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completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes; the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing (pgs. 3-5, instructions for I-9 completion).

87. USCIS fails to expressly disclose using a data processing system to complete the document.
88. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5), and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it to the current date gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

89. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and determining of an expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
90. USCIS fails to expressly disclose storing in a data storage for later retrieval the relevant data entered into the various ones of the fields in the step of entering relevant data into various ones of the fields; running an electronic review of the relevant data in the data storage to determine various ones of the employee's original documents associated with a particular employer which are expiring on a range of dates; and identifying to the employer the various ones of the employee's original documents which are determined to be expiring in the range of dates in the step of running the electronic review, such that the employer may begin processing updates for verification of employment eligibility to remain in compliance with employment eligibility verification requirements during the range of dates.
91. Ghosh discloses a system for tracking and maintaining document information, and automatically contacts and notifies system users of upcoming expirations (Para 0014).
92. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included storing in a data storage for later retrieval the relevant data entered into the various ones of the fields in the step of entering relevant data into various ones of the fields; running an electronic review of the relevant data in the data storage to determine various ones of the employee's original documents

associated with a particular employer which are expiring on a range of dates; and identifying to the employer the various ones of the employee's original documents which are determined to be expiring in the range of dates in the step of running the electronic review, such that the employer may begin processing updates for verification of employment eligibility to remain in compliance with employment eligibility verification requirements during the range of dates, as disclosed by Ghosh in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all document field data is current, valid, and usable for future use in the method.

93. **Claims 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS in view of Ghosh, and further in view of Stiegemeier.**

94. As per Claim 32, USCIS and disclose running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates (expiration dates) included in the relevant data; the step of running checks including the step of comparing with a list of acceptable documents the document type of the at least one of the employee's original documents viewed for employment verification (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C)..

95. However, USCIS and Ghosh fail to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.

96. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).

97. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier, in the system disclosed by Ghosh, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.

98. As per Claim 33, USCIS, Ghosh, and Stiegemeier fail to expressly disclose comprising the step of displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention.

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99. However, USCIS discloses revising the I-9 form and instructions when changes regarding regulations not incorporated into the verification rules are necessary (the form displayed on pgs. 3-5 was revised 11/21/91).

100. Furthermore, official notice is given that electronic notice boards (publicly viewable information updates) were well known and used at the time the invention was made.

101. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by ensuring that users are fully aware of all changes/updates to the method/system.

102. As per Claim 34, USCIS, Ghosh, and Stiegemeier disclose wherein employee data provided by the employee and entered into the data processing system is compared to data for the employee listed on a remote server to audit the accuracy of the employee data (USCIS: Employment Verification Pilot – SAVE Program, pgs. 22-25).

103. As per Claim 35, USCIS, Ghosh, and Stiegemeier disclose wherein the step of viewing at least one of the employee's original documents comprises the steps of viewing two separate documents of the employee's original documents, which includes the step of viewing a first one of the two separate documents establishing the identity of the

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employee and the step of viewing a second one of the two separate documents establishing the employment eligibility for the employee (USCIS employment verification process, list b and c documents, pgs. 3-5).

104. As per Claim 36, USCIS, Ghosh, and Stiegemeier fail to expressly disclose displaying an alert from a listing of alerts when a particular document type is selected from the list of acceptable documents.

105. However, Stiegemeier discloses filling in the fields of an electronic document electronically (abstract).

106. Furthermore, official notice is given that automatically displaying an alert in regards to a user action taken on an electronic form/document (beep, highlighting, blinking cursor) was well known and used at the time the invention was made.

107. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry, in the system disclosed by Stiegemeier, in the system disclosed by Ghosh, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by visually informing the consumers of actions taken as part of completing the method.

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108. As per Claim 37, USCIS, Ghosh, and Stiegemeier disclose wherein the documents are selected from a pull-down menu listing only acceptable types of documents (Stiegemeier: C6 L57-65, Drop-down list).
109. As per Claim 38, USCIS, Ghosh, and Stiegemeier fail to expressly disclose displaying employer editable tips, which are displayed when particular ones of the fields are selected.
110. However, USCIS discloses providing information on how to properly fill out the verification document (pgs. 3-5).
111. Furthermore, official notice is given that field specific help indexes (help windows) were well known and used at the time the invention was made.
112. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying employer editable tips which are displayed when particular ones of the fields are selected, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by ensuring that users correctly use and enter information into the document for further use/analysis in the method.
113. As per Claim 39, USCIS, Ghosh, and Stiegemeier disclose the step of storing the relevant data in a data storage, then running an electronic review of the relevant data to determine various data required for a particular employer to comply with verification of employment eligibility requirements, and displaying a report indicating such various data required for compliance (See rejection of claim 31).

***Response to Arguments***

114. Applicant's arguments filed 8/3/2005, with respect to Claims 1-67, have been considered but are moot in view of the new ground(s) of rejection.
115. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
116. In response to applicant's argument that there is no suggestion to combine the references (USCIS and Stiegemeier), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both USCIS and Stiegemeier disclose methods/systems for handling the verification of individuals for employment. Although USCIS discloses printing out a form and filling it out manually, it was known at the time of the invention that merely providing an

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automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date, gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

117. The Applicant has also submitted a declaration explaining the commercial success and long-felt need of the instant invention.

118. However, Prior art has been previously disclosed (PTO-892, Action Mailed 5/4/2005), which discloses an automated system for checking eligibility for employment ("Benelytics Announces Tools to Automate I-9 Processing," PR Newswire, September 10, 1997; and the USCIS website), and would show that the long term need and commercial success was determined prior to the instant applicant.

### ***Conclusion***

119. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

120. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for

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the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

121. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



JO  
November 7, 2005



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600